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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,204	01/18/2002	William Touzani	Touzani-1-1	7168
7590	04/01/2004		EXAMINER	LONEY, DONALD J
Loren G. Helmreich Browning Bushman, PC Suite 1800 5718 Westheimer Road Houston, TX 77057-5771			ART UNIT	PAPER NUMBER
1772				
DATE MAILED: 04/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/051,204	TOUZANI, WILLIAM
	Examiner	Art Unit
	Donald Loney	1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 January 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-12 and 24-28 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-12 and 24-28 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

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## DETAILED ACTION

### *Terminal Disclaimer*

1. The terminal disclaimer filed on January 2, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of serial number 09/961,947 has been reviewed and is accepted. The terminal disclaimer has been recorded.
2. The examiner has withdrawn the statutory type (35 USC 101) rejection since the applicant amended claim 1 and it is not a duplicate of claim 11 in parent application 09/961,947. The examiner has withdrawn the 35 USC 102 rejection over Boender in view of the applicant's amendment and arguments filed January 2, 2004.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Barber as set forth in the last office action dated October 6, 2003.

Barber teaches a holder containing parallel face sheets (10 and 12) interconnected with spacers (11 on the edges and 15, 16 in the interior). Element 13 and/or 14 can be considered the attaching member. Refer to Fig. Nos. 1-4 along with column 1, line 43 through column 2, line 19.

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***Response to Arguments***

4. Applicant's arguments filed January 2, 2004 have been fully considered but they are not persuasive. In response to applicant's argument that the tubular walls are configured to receive the clip, thereby allowing the clip to forcibly engage the face wall against the writing instrument body, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

5. Claims 1,2,4,5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Thorp.

Thorp discloses a plastic writing instrument holder containing parallel face and back walls separated by perpendicular spacers that form parallel tubular cells (16) there between which has a magnetic attaching means (20) located on the back surface in order to mount the holder. Refer to Figures 2 and 3 along with column 4, lines 3-29.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 3,6,7,9-12 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thorp in view of either Genzel or Kincheloe.

The primary reference teaches the invention substantially as recited, see above, except for the many different attaching means recited.

The references to Kincheloe teaches to use adhesive or Velcro® in order to attach a writing article holder to a structure. Refer to column 3, line 67 through column 4, line 13. Genzel teaches to use a Velcro® type strip to mount a pen holder to an article or a piece of clothing (applicant's claim 10). Refer to column 3, lines 24-30.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Thorp to substitute Velcro®, adhesive or any other of the recited attaching means for the magnetic attaching member of Thorp, as taught by either Genzel or Kincheloe, for the purpose of mounting the holder in its desired position motivated by the fact that Thorp teaches magnetic attaching members and that it is desirable to attach the article in place to a structure. The specific materials of claims 3 and 26 are also deemed obvious to one of ordinary skill in the art since the primary reference teaches to form the holder of plastic, of which the materials of claims 3 and 26 are commonly known as.

The references to Berger and Digiulio are cited to show magnetic (40) and adhesive (17) attaching means, respectively, for article holders.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon-Fri. 8AM-4PM, maxi-flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Donald Loney  
Primary Examiner  
Art Unit 1772

DJL:D.Loney  
03/26/04